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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/643,552	08/19/2003	Benjamin Meseguer	CH-7904/LeA 36,181	4924
34947	7590	12/21/2005		
LANXESS CORPORATION 111 RIDC PARK WEST DRIVE PITTSBURGH, PA 15275-1112			EXAMINER PERLINGER, SARAH E	
			ART UNIT	PAPER NUMBER
			1625	
DATE MAILED: 12/21/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/643,552	<b>Applicant(s)</b> MESEGUER ET AL.	
	<b>Examiner</b> Sarah E. Perlinger	<b>Art Unit</b> 1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-38 are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-9, 11-15, 17-18, drawn to furan-based compounds and processes for preparing furan-based compounds, classified in class 549, subclass 29.
- II. Claim 10, drawn to alcohol-based compounds, classified in class 568, subclass 763.
- III. Claim 16, drawn to polycyclic heterocycle compounds, classified in class 549, subclass 50.
- IV. Claims 19-28, 38, drawn to transition metal complexes and catalysts comprising transition metal complexes, classified in class 549, subclass 206.
- V. Claims 29-31, drawn to a process for preparing stereoisomerically enriched compounds comprising providing transition metal complexes, classified in class 549, subclass 206.
- VI. Claim 32, drawn to a process for catalyzing reactions comprising providing metal complexes according to claim 19, classified in class 549, subclass 206.
- VII. Claims 33-37, drawn to a process for preparing stereoisomerically enriched compounds, characterized in that the catalysts used are those which comprise transition metal complexes, classified in class 549, subclass 206.

The inventions are distinct, each from the other because:

Each group of claims is drawn to a patentably distinct "product" or a process of using patentably distinct products. Each distinct product is not related to any other distinct

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product i.e. furan-based compounds of group I are not related to a distinct compound such as the alcohol-based compounds of group II. The search for i.e. furan-based compounds of group I would not be coextensive or necessary for example for the search of group II of alcohol-based compounds of group II. Such independent and distinct products must be examined separately.

Inventions IV and V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the process of preparing stereoisomerically enriched compounds can be achieved using a different product than that of group IV. For example, dimethyl cyclohexene-1,2-dicarboxylate can be hydrogenated over a Platinum catalyst to yield dimethyl cyclohexane-*cis*-1,2-dicarboxylate.

Inventions IV and VI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the process of catalyzing reactions can be achieved using a different product than group IV. For example, hydrochloric acid can be used to catalyze an ester hydrolysis reaction.

Inventions IV and VII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product

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as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the process for preparing stereoisomerically enriched compounds by catalytic hydrogenation of olefins can be achieved using a different product than group IV. For example, dimethyl cyclohexene-1,2-dicarboxylate can be hydrogenated over a Platinum catalyst to yield dimethyl cyclohexane-*cis*-1,2-dicarboxylate.

Because these inventions are independent and distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are independent and distinct for the reasons given above and the search required for one group is not required for any other group, searching all the inventions would be burdensome, therefore restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Should applicant traverse on the ground that the groups are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the groups to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention. In the instant case, applicant will not have patentability over any of the claims because there is anticipation for group IV over Jackson et al. (*Aust. J. Chem.* 1982, 35, 2069-2075).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sarah E. Perlinger whose telephone number is 571-272-5574. The examiner can normally be reached on 8:30 a.m.-5:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AP

12/15/05



Celia Chang  
Primary Examiner  
Art Unit 1625